

REMARKS

Summary:

The claims currently pending in this application are 1-3, 5-7, 9-11, 13-15, 25-29, 31-33 and 77-81.

In the Office Action dated December 11, 2008:

- (1) claims 1, 5-7, 11, 13, 25, 31-33 and 77 were rejected under 35 U.S.C. § 102(b) as anticipated by *Walsh* (U.S. Patent 5,746,871),
- (2) claims 9-10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Walsh* in view of *Decottignies, et al.* (U.S. Patent No. 5,097,651),
- (3) claims 2, 14-15 and 26-28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Walsh* in view of *McNown* (U.S. Patent No. 5,447,270), and
- (4) claims 78-81 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Walsh* in view of *Meyers* (U.S. Patent No. 4,177,715).

RESPONSE TO REJECTIONS

(1) Anticipation by Walsh

Claims 1, 5-7, 11, 13, 25 and 31-33 were rejected as anticipated by *Walsh* under 35 U.S.C. § 102(b). Applicant submits that *Walsh* does not anticipate independent claims 1 and 25, and, it follows, the claims dependent thereon, because *Walsh* does not disclose all the limitations recited in independent claims 1 and 25.

Comparing the disclosure of *Walsh* to claims 1 and 25, *Walsh* discloses a method of making paperboard cartons from a web of paperboard 2, which is shown in Fig. 2 as being the width of two carton blanks. Strips 6 of relatively flexible material, such as kraft paper (col. 2,

lines 54-58), are positioned at spaced apart locations across the web. Also, longitudinal fold lines, such as the horizontal fold lines 54 shown in Fig. 5 of *Walsh*, define between them panel portions, each of which becomes a plurality of panels 56, 58, 60. These panel portions correspond to the “longitudinally extending panel portions” recited in claims 1 and 25. The web and ribbons are cut at 66 to form carton blanks.

However, *Walsh* does not disclose at least the recitation in step (b) of claim 1 that (emphasis added):

... the first ribbon being positioned to overlie and adhere to substantially all of, but not beyond, a first selected longitudinally extending panel portion of the web, and the second ribbon being positioned to overlie and adhere to substantially all of, but not beyond, a second selected longitudinally extending panel portion of the web, the first ribbon and the second ribbon not extending across the longitudinal fold lines;

and in step (b) of claim 25 that (emphasis added):

... the first ribbon being positioned on, and adhered to, substantially all of, but not beyond, a first longitudinally extending panel portion of the web of noncorrugated paperboard, and a second ribbon being positioned on, and adhered to, substantially all of, but not beyond, a second longitudinally extending panel portion of the web, the first ribbon and the second ribbon not extending across the longitudinal fold lines;

The Examiner seems to assume that the ribbons 6 of *Walsh* do not extend across horizontal fold lines 54, and therefore that the underlined limitations are anticipated. However, Applicant can find no express or explicit disclosure in *Walsh* either that the ribbons (strips) 6 do not extend across the horizontal fold lines 54, and/or that, for example, the bottom ribbon 6 shown in Fig. 2 is narrower than the distance between the lowest horizontal score line 54 and the bottom edge of the carton blank of Fig. 5 (i.e., that bottom ribbon 6 is narrower than panels 58), so that the bottom ribbon would not extend across the lowest score line 54.

“To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently.” In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). In the present case, since *Walsh* does not explicitly disclose the above-underlined limitations, any finding of anticipation must be based on inherency. However, “[i]nherent anticipation requires that the missing descriptive material is ‘necessarily present,’ not merely probably or possibly present, in the prior art.” Trinitec Industries, Inc. v. Top-U.S.A. Corp., 295 F.3d 1292, 63 USPQ2d 1597 (Fed. Cir. 2002) (citing In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)). Since it is at least possible, and, Applicant submits, probable, that the ribbons 6 of *Walsh* extend across the horizontal fold lines 54, *Walsh* does not inherently anticipate the underlined limitations.

On page 5 of the Office Action, the Examiner notes that “There is no mention [in *Walsh*] of fold lines 54 being formed in strip material 6 but only in material 2; see col. 3, lines 42+.” Apparently the Examiner draws an inference that ribbons 6 do not cross fold lines 54 from this “non-disclosure” by *Walsh*. However, *Walsh* also does not disclose that fold lines 54 are formed in film 10, even though film 10 covers the entire width of the web 2, including fold lines 54. Therefore, since *Walsh* does not disclose that fold lines 54 are formed in film 10, even though film 10 clearly extends across them, one cannot draw any conclusion about whether or not ribbons 6 extend across fold lines 54.

In the Amendment filed on October 23, 2008, Applicant included a comparison of Figs. 2 and 5 of *Walsh*, on the same scale, to show that, if anything, the strips (ribbons) 6 would extend from the edges of the carton of Fig. 5 across the horizontal (longitudinal) fold lines 54. The Examiner, citing Hockerson-Halberstadt, Inc. v. Avia Group Int’l, 222 F.3d 951, 55 USPQ2d 1487 (Fed. Cir. 2000) and MPEP 2125, states that this argument is not persuasive, because

“when the reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurement of the drawing features are of little value” (Office Action, p.5). Applicant does not disagree with this general proposition, however, even if the arguments based on *Walsh's* drawings are “of little value”, the point is that they show that it is as least as likely as not, and probably more likely than not, that the ribbons 6 of *Walsh* extend across fold lines 54.

A further indication that the ribbons 6 of *Walsh* extend across longitudinal (horizontal) fold lines 54 can be found in *Walsh's* Fig. 9. In the method disclosed by *Walsh*, modified cut lines 52 are formed in the web 2 of relatively rigid material, e.g., by means of cutting rule 70, thereby defining removable portions 64. The portions 64 are then removed by hook shaped head portions 84, leaving ribbons 6 and film 10 in the resulting spaces (col. 4, lines 20-36). Fig. 9 is an enlarged portion of the upper right hand corner of *Walsh's* Fig. 6, with the portion 64 of the web removed, showing ribbon 6 in the space remaining. Attention is directed to the fact that, at the lower right of Fig. 9, at the bottom of the space, a V-shaped portion of the space extends down beyond the longitudinal (horizontal) fold line between panel portions 56 and 60. If, as the Examiner asserts, *Walsh's* ribbons 6 do not extend across longitudinal fold lines 54, then in Fig. 9 the lower edge of ribbon 6 would be shown in the space as a horizontal line (also in Fig. 6). However, since there is no such horizontal line in Fig. 9 above the V-shaped portion of the space, it must be concluded that ribbon 6 extends to at least the bottom of the V-shaped portion, i.e., that it extends across the longitudinal fold line. The same conclusion must be drawn from the fact that the top edge of the bottom ribbon 6 is not shown in the spaces at the bottom of Fig. 6.

To reiterate, in order to anticipate independent claims 1 and 25, *Walsh* must disclose, expressly or inherently, that ribbons 6 do not extend across fold lines 54. Since *Walsh* does not

disclose this expressly, it cannot anticipate unless the claimed feature is inherent, but in order to be inherent, the missing descriptive material must be “ ‘necessarily present,’ not merely probably or possibly present, in the prior art.” Trinitec Industries, Inc. v. Top-U.S.A. Corp., 295 F.3d 1292, 63 USPQ2d 1597 (Fed. Cir. 2002) (citing In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)). As Applicant has demonstrated, both in the previous Amendment and in the present Reply, it is as least as likely as not (and, Applicant submits, more likely than not, especially in view of the V-shaped portion showing extension of the ribbon 6 beyond fold line 54 discussed above) that the ribbons 6 of *Walsh* extend across the fold lines 54. Therefore, *Walsh* does not meet the test for anticipation by inherency, and the rejection of claims 1 and 25, and, it follows, of claims 5-7, 11, 13 and 31-33 dependent thereon, as anticipated by *Walsh* under 35 U.S.C. §102(b) should be withdrawn.

(2) **Walsh In View of Decottignies**

Claims 9 and 10 were rejected as unpatentable over *Walsh* in view of *Decottignies*, under 35 U.S.C. § 103(a). This rejection is traversed for at least the following reasons:

As discussed above, *Walsh* does not disclose, expressly or inherently, all the limitations of parent claim 1. The Examiner cites *Decottignies* as evidence that it would have been obvious to print indicia on the strips 6 of *Walsh*. However, whatever may be the merits of this position, *Decottignies* does not disclose or render obvious the limitations of parent claim 1 which, as discussed above, are not disclosed by *Walsh*. The rejection therefore should be withdrawn.

(3) **Walsh In View of McNown**

Claims 2, 14, 15 and 26-28 were rejected as unpatentable over *Walsh* in view of *McNown*, under 35 U.S.C. § 103(a). This rejection is traversed for the following reasons:

(A) *McNown* does not overcome the deficiencies in *Walsh* as discussed above with respect to parent claims 1 and 25.

(B) The rejected claims require that at least one of the ribbons comprises paperboard. *Walsh* discloses that the strips (ribbons) 6 are made “of a relatively flexible material, such as kraft paper” (col. 2, lines 55 and 56), whereas the web 2 is made “of a relatively rigid material, such as paperboard” (col. 2, lines 53 and 54). The relative flexibility of the strips 6 in *Walsh* is necessary in order for the strips to function as the patentee intended, namely to form a barrier between the rigid paperboard material 2 and the continuous film 10 of relatively flexible fluid impervious material to allow (i) the rigid material 2 to be cut along cut lines without piercing the film 10 while still allowing (ii) flexibility to fold the blank into a carton. These functions would be negated if the strips 6 were made of paperboard.

The Examiner characterizes *Walsh*'s ribbons 6 as “reinforcing ribbons”, but while they may incidentally provide some minimal reinforcement, the purpose of ribbons 6 is not to reinforce, but to prevent adhesion of film 10 to web 2 in selected areas. The same effect can be achieved by eliminating ribbons 6, and instead applying adhesive 22 in rows (compare Figs. 3 and 4 of *Walsh*, and see col. 3, lines 5-11 and 34-41). The Examiner states on page 5 of the Office Action that “the functionality of the strips of *Walsh* do more than provide a flexible barrier between the layers as argued”, but the Examiner cites no basis for this statement, and Applicant is aware of none. In fact, as shown in Fig. 4 of *Walsh*, ribbons 6 are not even required. Applicant submits that *Walsh* is devoid of any suggestion that ribbons 6 be provided for the purpose of reinforcement of the web 2.

Accordingly, it would not have been obvious to modify *Walsh* in view of *McNown* by making the strips 6 of *Walsh* out of the same “relatively rigid material,” i.e., paperboard, as the

web 2, since there is no teaching or suggestion in *Walsh* that ribbons 6 are for the purpose of reinforcement, and to do so would render *Walsh* unsuitable for its intended purpose and would change the principle of operation of *Walsh*, both of which are improper; see MPEP 2143.01(V) and (VI).

(4) **Walsh In View of Meyers**

Claims 78 to 81 were rejected as unpatentable over *Walsh* in view of *Meyers*, under 35 U.S.C. § 103(a). This rejection is traversed for at least the following reasons:

As discussed above, *Walsh* does not disclose, expressly or inherently, all the limitations of parent claim 1. The Examiner cites *Meyers* as evidence that it would have been obvious to provide a third, partially adhered ribbon in the method of *Walsh*. However, whatever may be the merits of this position, *Meyers* does not disclose or render obvious the limitations of parent claim 1 which, as discussed above, are not disclosed by *Walsh*. The rejection therefore should be withdrawn.

Conclusion

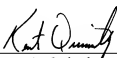
In view of the foregoing, Applicant submits that the claims now pending in the application are patentable over the cited art, and requests that the rejections be withdrawn and the application passed to issue. If any issues remain unresolved, however, Applicant's attorney would welcome a telephone conference with the Examiner in order to resolve them.

Authorization

The Commissioner is hereby authorized to charge any fees that may be required for the timely consideration of this Reply to Office Action to Deposit Account No. 09-0528.

Respectfully submitted,

3/11/09
Date



Keats A. Quinalty
Registration No. 46,426
Ian A. Calvert
Registration No. 50,186

Customer No. 26158
WOMBLE CARLYLE SANDRIDGE & RICE
P. O. Box 7037
Atlanta, Georgia 30357-0037
(404) 879-2423 (Telephone)
(404) 879-2923 (Facsimile)

Docket No.: R029 1056